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10/763,484	01/23/2004	Nausheen Moulana	MWS-107	7031

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EXAMINER

ZEE, EDWARD

ART UNIT	PAPER NUMBER
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2435

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/763,484	Applicant(s) MOULANA ET AL.	
	Examiner EDWARD ZEE	Art Unit 2435	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10 and 12-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10 and 12-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the amendments filed on July 22nd, 2008. Claims 1-5, 8, 10, 12, 13, 15-18 and 20-24 have been amended; Claims 9 and 11 remain cancelled; Claims 1-8, 10 and 12-24 are pending and have been considered below.

Claim Objections

2. Claim 10 is objected to because of the following informalities: The Examiner notes that line 6 should be amended to recite, “checking a media type **of** the” or the like. Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 21-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The Examiner notes that Claims 21-23 now disclose **a medium comprising** of instructions, thus appear to be drawn towards software per se. Software is not a series of steps or acts and this is not a process. Software is not a physical article or object and as such is not a machine or manufacture. Software is not a combination of substances and therefore not a compilation of matter. Thus, software by itself does not fall within any of the four categories of invention. Therefore, Claims 21-23 are not statutory.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1, 4-8, 10 and 12-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cookson et al. (5,896,454) in view of Cohen (2006/0259975).

Claims 1 and 21: Cookson et al. discloses a method and computer-readable optical medium containing instructions for preventing use of an unauthorized copy of a software program comprising the steps of:

- a. determining a media type of an optical medium containing the software program [column 5, lines 23-27];
- b. and inhibiting execution(*ie. further play is aborted*) of the software program stored on the optical medium by preventing execution of the software program if the optical medium has media type that indicates that the optical media is copied [column 5, lines 44-49].

However, Cookson et al. does not explicitly disclose providing a protection program on the optical medium which performs searching for a file on an optical medium containing the software program prior to determining a media type of the optical medium and inhibiting execution of the software program stored on the optical medium if the file is missing on the optical medium.

Nonetheless, Cohen discloses providing a protection program(*ie. authentication module*) on the optical medium which performs searching for a file on a medium containing a software program and inhibiting execution of the software program stored on the medium if the file is

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missing(*ie. activating authentication module...performing read operations...preventing access to the content*) [page 2, paragraph 0028 & figure 4].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to further modify the invention disclosed by Cookson et al. with the additional features disclosed by Cohen in order to prevent using illicitly copied software, as suggested by Cohen [abstract].

Claim 4: Cookson et al. and Cohen disclose a method as in claim 1, and Cohen further discloses that the step of inhibiting the execution of the software program comprises preventing execution of the software program [page 2, paragraph 0028 & figure 4].

Claim 5: Cookson et al. and Cohen disclose a method as in claim 1 above, and Cookson et al. further discloses that the step of determining the media type comprises inserting the optical medium in a drive of a computer and reviewing a medium-type code field contained in a mode parameter header(*lead-in section*) of the optical medium [column 3, lines 22-27].

Claim 6: Cookson et al. and Cohen disclose a method as in claim 5, but Cookson et al. does not explicitly disclose that the drive is a CD-R/W drive. However, it would have been obvious to one of ordinary skill in the art at the time of invention to use a CD-R/W drive or any other optical media drive. One would have been motivated to do so in order to apply this method to other media formats.

Claim 7: Cookson et al. and Cohen disclose a method as in claim 1 above, and Cookson et al. further discloses that a media type indicates that the optical medium is copied is one of a write-once media type and an erasable/rewriteable media type(*writeable disk*) [column 2, lines 24-25 and column 5, lines 39-48].

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Claim 8: Cookson et al. and Cohen disclose a method as in claim 1 above, and Cookson et al. further discloses the step of executing the software program stored on the optical medium if the step of determining determines the optical medium to be an optical read-only medium [column 5, lines 23-27].

Claims 10 and 22: Cookson et al. discloses a method and computer-readable optical medium containing instructions for authenticating an original optical medium comprising the steps of inserting the optical medium in a drive of a computer(*player/recorder*) and checking a media type of the optical medium [column 4, lines 64-67 and column 5, lines 23-27], but does not explicitly disclose that the drive is a CD-R/W drive. However, it would have been obvious to one of ordinary skill in the art at the time of invention to use a CD-R/W drive or any other optical media drive. One would have been motivated to do so in order to apply this method to other media formats.

Furthermore, Cookson et al. does not explicitly disclose providing a protection program on the optical medium which performs searching for a file on an optical medium containing the software program prior to determining a media type of the optical medium and inhibiting execution of the software program stored on the optical medium if the file is missing on the optical medium.

Nonetheless, Cohen discloses providing a protection program(*ie. authentication module*) on the optical medium which performs searching for a file on a medium containing a software program and inhibiting execution of the software program stored on the medium if the file is missing(*ie. activating authentication module...performing read operations...preventing access to the content*) [page 2, paragraph 0028 & figure 4].

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Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to further modify the invention disclosed by Cookson et al. with the additional features disclosed by Cohen in order to prevent using illicitly copied software, as suggested by Cohen [abstract].

Claim 12: Cookson et al. and Cohen disclose a method as in claim 10 above, and Cookson et al. further discloses that the step of checking a media type comprises reviewing a medium-type code field contained in a mode parameter header(*lead-in section*) of the optical medium [column 3, lines 22-27].

Claims 13-15: Cookson et al. and Cohen disclose a method as in claim 10 above, and Cookson et al. further discloses:

a. the step of checking the media type comprises verifying that the optical medium has a read-only media type and that it is indicative that the optical medium is an original version(*pressed disk*) [column 5, lines 23-27];

b. the step of executing a software program stored on the optical medium if the optical medium has a read-only media type [column 5, lines 23-27] .

Claim 16: Cookson et al. and Cohen disclose a method as in claim 10 above, and Cookson et al. further discloses that the step of checking the media type comprises identifying if the media type is one of a write-once media type and an erasable/rewritable media type(*writeable disk*) [column 2, lines 24-25 and column 5, lines 23-27].

Claim 17: Cookson et al. and Cohen disclose a method as in claim 16 above, and Cookson et al. further discloses the step of inhibiting execution of a software program stored on the optical

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medium if the step of checking identifies that the media type is one of a write-once media type and an erasable/rewritable optical media type [column 5, lines 39-48].

Claims 18 and 23: Cookson et al. discloses a method and computer-readable optical medium containing instructions for preventing execution of an unauthorized copy of a software program stored on an optical medium comprising the steps of:

- a. determining a media type of the optical medium [column 5, lines 23-27];
- b. and executing the software program stored on the optical medium if the optical medium has a media type that indicates that the optical medium is an original version(*pressed disk*) [column 5, lines 23-27].

However, Cookson et al. does not explicitly disclose providing a protection program on the optical medium which performs searching for a file on an optical medium containing the software program prior to determining a media type of the optical medium and inhibiting execution of the software program stored on the optical medium if the file is missing on the optical medium.

Nonetheless, Cohen discloses providing a protection program(*ie. authentication module*) on the optical medium which performs searching for a file on a medium containing a software program and inhibiting execution of the software program stored on the medium if the file is missing(*ie. activating authentication module...performing read operations...preventing access to the content*) [page 2, paragraph 0028 & figure 4].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to further modify the invention disclosed by Cookson et al. with the additional features

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disclosed by Cohen in order to prevent using illicitly copied software, as suggested by Cohen [abstract].

Claim 19: Cookson et al. and Cohen disclose a method as in claim 18 above, and Cookson et al. further discloses that a read-only media type indicates that the optical medium is an original version [column 5, lines 23-27].

Claim 20: Cookson et al. and Cohen disclose a method as in claim 18 above, and Cookson et al. further discloses the step of inhibiting execution of the instructions if the optical medium does not have a read-only media type [column 5, lines 44-49].

Claim 24: Cookson et al. discloses an electronic device comprising:

- a. memory for storing computer program instructions. The examiner notes that it is inherent for the device to have memory for storing computer program instructions if the device is executing the instructions;
- b. a processor for executing the stored computer program instructions [column 4, lines 42-43];
- c. and an optical drive(*player/recorder*) for receiving an optical medium containing a software program, the computer program instructions including instructions for determining the media type of the optical medium and inhibiting execution of the software program stored on the optical medium if the optical medium has media type that indicates that the optical medium is copied, but does not explicitly disclose that the optical drive is a CD-R/W drive [column 4, lines 40-42].

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However, it would have been obvious to one of ordinary skill in the art at the time of invention to use a CD-R/W drive or any other optical media drive. One would have been motivated to do so in order to apply this method to other media formats.

Furthermore, Cookson et al. does not explicitly disclose providing a protection program on the optical medium which performs searching for a file on an optical medium containing the software program prior to determining a media type of the optical medium and inhibiting execution of the software program stored on the optical medium if the file is missing on the optical medium.

Nonetheless, Cohen discloses providing a protection program(*ie. authentication module*) on the optical medium which performs searching for a file on a medium containing a software program and inhibiting execution of the software program stored on the medium if the file is missing(*ie. activating authentication module...performing read operations...preventing access to the content*) [page 2, paragraph 0028 & figure 4].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to further modify the invention disclosed by Cookson et al. with the additional features disclosed by Cohen in order to prevent using illicitly copied software, as suggested by Cohen [abstract].

6. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cookson et al. (5,896,454) in view of Cohen (4,462,078) and further in view of Granger et al. (6,480,959).

Claims 2 and 3: Cookson et al. and Cohen disclose a method as in claim 1 above, but does not explicitly disclose that the step of inhibiting the execution of the software program comprises

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preventing execution of selected features of the software program by determining a set of features of the software program to execute.

However, Granger et al. discloses a similar method for controlling the use of computer programs and further discloses preventing execution of selected features of the software program by determining a set of features of the software program to execute(*ie. specifies particular applications features and enables or disables specific features*) [column 25, lines 27-30].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the method disclosed by Cookson et al. and Cohen with the features disclosed by Granger et al. in order to allow execution of specific features dependent on the application and/or users, as suggested by Granger et al. [column 25, lines 27-30].

Response to Arguments

7. Applicant's arguments with respect to claims 1, 10, 18 and 21-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cohen (2002/0146121).

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWARD ZEE whose telephone number is (571)270-1686. The examiner can normally be reached on Monday through Thursday 9:00AM-5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EZ

October 6, 2008

/KimYen Vu/

Supervisory Patent Examiner, Art Unit 2435